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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,910	07/30/2003	Roy Lillqvist	60091.00217	6100

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EXAMINER	
ADAMS, CHARLES D	
ART UNIT	**PAPER NUMBER**
2164	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/629,910	LILLQVIST ET AL.	
	Examiner	Art Unit	
	Charles D. Adams	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12-23-04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the 4th paragraphs of 35 U.S.C. 112, 4th:

> Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

2. Claim 4 is rejected under 35 U.S.C. 112, 4th paragraph, because claim 4 does not further limit claims 1 or 3.

Claim 1 states "converting at least one of said at least one domain name into a second format in which at least two successive labels of the at least one of said at least one domain name are combined to form a single label".

Claim 4 states that "the converting step is not performed when the examining step indicates that the domain name does not include at least the predetermined number of labels".

Therefore, because converting is a required step of claim 1 and claim 4 states that it is not performed under certain conditions, claim 4 does not further limit claim 1 or claim 3.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4 and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al. (US Pre-Grant Publication 2002/0083198).

As to claim 1, Kim et al. teaches a method for enhancing database performance in a domain name system (DNS), the method comprising the steps of:

receiving data to be supplied to database operations, the data including at least one domain name comprising a plurality of successive labels, said at least one domain name being in a first format (see paragraph [0034]. In the first format, the labels are separated by dashes);

converting at least one of said at least one domain name into a second format in which at least two successive labels of the at least one of the said at least one domain name in the second format (see paragraphs [0035]. The dashes are removed, combining all of the labels).

Supplying the data to the database operations, the supplied data including at least one domain name in the second format (see paragraphs [0035]).

As to claim 2, Kim et al. teaches further comprising a step of examining whether a domain name fulfills a predetermined condition in the first format (see paragraph [0034]. Conversion only occurs if the number entered contains a '#' sign).

As to claim 3, Kim et al. teaches wherein the examining step includes examining whether said domain name includes at least a predetermined number of labels beyond a given origin, said labels having a predetermined maximum length (see paragraphs [0030] and [0034]. If there is more than one distinct label, they will be separated. The labels have a predetermined max length of 15 digits).

As to claim 4, Kim et al. teaches wherein the converting step is performed for said domain name when the examining step indicates that the domain name includes at least the predetermined number of labels beyond the given origin, said labels having the predetermined maximum length (see paragraphs [0030] and [0034]. The step of combining is performed when there is more than one label).

The remainder of the claim receives no patentable weight. See the rejection of claim 4, under 35 U.S.C. 112th paragraph, listed above.

As to claim 9, Kim et al. teaches:

first means for receiving data to be supplied to database operations, the data including at least one domain name comprising a plurality of successive labels, said at least one domain name being in a first format (see paragraph [0034]);

second means for converting at least one of said at least one domain name into a second format in which at least two successive labels of the at least one of the said at least one domain name are combined for form a single label (see paragraph [0034]); and

third means for supplying the data to database operations, the supplied data including at least one domain name in the second format (see paragraph [0035]).

As to claim 10, Kim et al. teaches further comprising fourth means for examining whether a domain name fulfills a predetermined condition, the second means being configured to convert the domain name into the second format when the domain name fulfills the predetermined condition (see paragraph [0034]. Conversion only occurs if the number entered contains a '#' sign).

As to claim 11, Kim et al. teaches:

A first interface for receiving data to be supplied to database operations, the data including at least one domain name comprising a plurality of successive labels, said at least one domain name being in a first format (see paragraph [0034]);

A modification module operably connected to the first interface for converting at least one of said at least one domain name into a second format in which at least two successive labels of the at least one of said at least one domain name form a single label (see paragraph [0035]); and

A second interface, operably connected to the modification module for supplying the data to database operations, the supplied data including at least one domain name in the second format (see paragraph [0035]).

As to claim 12, Kim et al. teaches a computer program product, the product comprising computer readable code being configured to cause a computer to substantially perform the steps of claim 1 when executed by said computer (see paragraph [0023]).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (US Pre-Grant Publication 2002/0083198).

As to claim 5, Kim et al. does not teach wherein the predetermined number of labels is three.

However, it would have been obvious for one skilled in the art at the time the invention was made to have modified Kim et al. to include that limitation, because only a size (predetermined number of labels) is changing (see *In re Rose,* 220 F .2d 459, 105 USPQ 237 (CCPA 1955), *In re Rinehart*, 531 F .2d 1048, 189 USPQ 143 (CCPA 1976), *Gardner v. TEC Systems, Inc.*, 725 F .2d 1338, 220 USPQ 777 (FED Cir. 1984), *cert.*

denied, 469 U.S. 830, 225 USPQ 232 (1984) and MPEP 2144.04 IV.A – Changes in Size/Proportion).

As to claim 6, Kim et al. does not teach wherein the predetermined maximum length is one byte.

However, it would have been obvious for one skilled in the art at the time the invention was made to have modified Kim et al. to include that limitation, because only a size (predetermined maximum length) is changing (see *In re Rose,* 220 F .2d 459, 105 USPQ 237 (CCPA 1955), *In re Rinehart*, 531 F .2d 1048, 189 USPQ 143 (CCPA 1976), *Gardner v. TEC Systems, Inc.*, 725 F .2d 1338, 220 USPQ 777 (FED Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984) and MPEP 2144.04 IV.A – Changes in Size/Proportion)).

As to claim 7, Kim et al. does not teach wherein the predetermined maximum length is one byte.

However, it would have been obvious for one skilled in the art at the time the invention was made to have modified Kim et al. to include that limitation, because only a size (predetermined maximum length) is changing (see *In re Rose,* 220 F .2d 459, 105 USPQ 237 (CCPA 1955), *In re Rinehart*, 531 F .2d 1048, 189 USPQ 143 (CCPA 1976), *Gardner v. TEC Systems, Inc.*, 725 F .2d 1338, 220 USPQ 777 (FED Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984) and MPEP 2144.04 IV.A – Changes in Size/Proportion)).

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (US Pre-Grant Publication 2002/0083198) in view of Khello et al. (US Pre-Grant Publication 2003/0007482).

As to claim 8, Kim et al. teaches a method according to claim 1.

Kim et al. does not teach:

-receiving data including another domain name in the second format; and

-converting the another domain name received in the second format back to the first format.

Khello et al. teaches:

-receiving data including another domain name in the second format (see paragraph [0055] and Figure 8. Numbers are entered in a format of a single label); and

-converting the another domain name received in the second format back to the first format (see paragraph [0055] and Figure 8. Numbers entered in a format of a single label are converted to numbers comprised of multiple labels).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified Kim et al. by the teaching of Khello et al., since Khello et al. teaches that "the present invention may be used to establish a multimedia or other communications session that includes one or more of the following example applications: voice-over-IP, web surfing, e-mail, videoconferencing, video-on-

demand, audio-on-demand, intranet-work access, gaming, and gambling, either with or without a circuit switched voice communication" (see paragraph [0054]).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles D. Adams whose telephone number is (571) 272-3938. The examiner can normally be reached on 8:30 AM - 5:00 PM, M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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